

### Remarks

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 27 remain in this application.

#### **1. Allowed Claims/Subject Matter**

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 19 – 24 and 26 are patentable, and would be allowable if rewritten in independent form.

#### **2. Claim Objections**

The Examiner objects to claim 19 and claim 25 because of the phrase “said frame has a second opening...” In particular, the Examiner asserts that the phrase “a second opening” lacks antecedent basis. The applicant traverses the rejection by pointing out that use of the indefinite article, “a” or “an”, is the customary way of establishing antecedent basis. The Examiner states that he is confused by the use of the term “second opening” because claim 1 does not specifically recite a “first opening.” However, a first opening is recited in claim 1. The first opening is an opening in the wall plate. The second opening just so happens to be an opening in the frame.

Accordingly, the applicant respectfully requests that the objections to claim 19 and claim 25 be withdrawn.

#### **3. § 102 Rejections**

The Examiner has rejected claim 1 and claim 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,879,101 to McKissic.

Claim 1 is directed to a modular electrical device for use in an electric circuit. The device includes a housing configured to accommodate a frame member selected from a plurality of frame members. Each frame is configured to accommodate at least one wiring assembly. An electrical wiring assembly is chosen from a plurality of electrical wiring assemblies. Each of the plurality of electrical wiring assemblies has a different functional configuration. Each of the plurality of electrical wiring assemblies is sized to fit in the selected frame member. A set of terminal contacts is selected from a plurality of sets of

terminal contacts. Each set of terminal contacts is matched to accommodate one of the plurality of electrical wiring assemblies. A wall plate defines a first opening, the housing configured to be disposed within the first opening.

McKissic is directed to a receptacle adapted for permanent mounting in a permanently mounted conventional electrical box mounted in a wall or other suitable supporting surface. The receptacle is mounted inwardly of the conventional electrical box. An interchangeable electric switch module is adapted to fit snugly in the conventional electrical box. The electric switch module includes a plurality of plugs that are configured to be inserted into receptacle sockets disposed in the receptacle. The switch module is energized when inserted into a properly wired receptacle.

According to **MPEP 2131**, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Before responding to the Examiner’s rejection, the Applicant points out that McKissic is nothing like the present claimed invention. As will be shown below, the Examiner misidentifies virtually all of the components described in the McKissic patent.

The Examiner asserts that element 14 in the McKissic patent is a device housing. It is not a device housing. Figure 1 and col. 3, lines 35 – 51 clearly identify reference numeral 14 as being a conventional electrical wall box. Applicant notes that the housing recited in claim 1 is configured to be disposed within the wall plate, whereas the wall box 14 shown in Figure 1 of McKissic does not fit into a wall plate, but rather is covered by a wall plate. Thus, the Examiner fails to shown where McKissic discloses a device housing as recited in claim 1.

The Examiner misidentifies reference numeral 11 as being a frame member configured to accommodate at least one wiring assembly. However, Figure 1 and col. 3, lines 59 – 61 clearly identify reference numeral 11 as being a receptacle 11. Receptacle 11 is shown as being inserted into the wall box 14 and connected to wires 49 by way of terminal screws 48. On the other hand, claim 1 recites that the electrical assemblies are sized to “fit within the selected frame member.” Clearly, receptacle 11 (or 11’ for that matter) is comprised of a flat planar surface with sockets. While plug blades may fit within the sockets, wiring assemblies cannot. Accordingly, the Examiner does not show where McKissic discloses a frame as recited in claim 1.

The Examiner incorrectly refers to reference numeral 12 as being a wiring assembly sized to fit in a selected frame member. On the other hand, Figure 1 and col. 4, lines 27 – 57 refer to element 12 as being a plug-in switch module that includes plug blades that fit into receptacles. In fact, the body of plug-in module 12 and the body of receptacle 11 are of substantially the same dimensions and are disposed face-to-face when in use. Referring to Figure 1, one does not fit within the other. Accordingly, the Examiner does not show where McKissic discloses a wiring assembly sized to fit in a selected frame member as recited in claim 1.

The Examiner further misidentifies reference element 48 as being the terminal contacts recited in claim 1. Figure 1 and col. 3, line 68 refers to reference numeral 48 as being a terminal screw. Those of ordinary skill in the art understand that terminal screws and terminal contacts refer to distinct structural elements. Further, terminal screws 48 appear to be generic screws that may be used to connect any device to a wire. Virtually every electrical device known to mankind includes terminal screws such as those identified by reference numeral 48. On the other hand, the present invention recites terminal contacts matched to a specific type of wiring assembly. As such, the Examiner does not show where McKissic discloses a set of terminal contacts being matched to accommodate one of the plurality of electrical assemblies recited in claim 1.

Regarding claim 25, the Examiner fails to show a frame configured to accommodate one or more wiring assemblies such that the electrical assemblies are sized to “fit within the selected frame member,” he also fails to show a frame having a second opening. The Examiner also calls reference numeral 71 an “interchangeable assembly.” However, McKissic calls it a flange. See col. 4, line 44.

The Applicant respectfully points out that the Examiner does not make a prima facie case of anticipation. As noted above, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In this case, the Examiner fails to show where McKissic describes any of the recited claim elements. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 and claim 25 under 35 U.S.C. § 102(b).

#### 4. § 103 Rejections

A. The Examiner has rejected claims 2 – 10 under 35 U.S.C. § 103 as being unpatentable for obviousness over “McKissing.” The Examiner refers to U.S. Patent No. 3,707,697. However, the inventor of the ‘697 patent is John Izumi. The applicant believes, based on the context of the rejection, that the Examiner is referring to the McKissic patent described above (U.S. Patent No. 3,879,101).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner does not make a *prima facie* case of obviousness under 35 U.S.C. § 103 because the prior art reference does not teach or suggest all the claim limitations. In particular, as pointed out above, McKissic does not teach or describe any of the elements recited in claim 1. Further, the Examiner admits that, in regard to claim 2, McKissic does not teach or suggest an electrical wiring assembly that includes a first and second switch. In fact, the Examiner fails to show where McKissic teaches any of the elements recited in claims 2 – 10.

The Examiner does not make a *prima facie* case of obviousness under 35 U.S.C. § 103 because the Examiner must provide some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. On the other hand, the Examiner merely inserts a standard P.T.O. form paragraph reciting a 1960 case brief that is inapplicable to the present invention. *In re Harza* is directed to a situation wherein the working parts of a device were duplicated. This is not the problem solved by the inventors of claims 2 – 10. The present claimed invention provides one or more additional switches within the same space and form factor used to provide a single switch. This requires a modification of the frame element and the inclusion of another set of matching terminal contacts.

In light of the aforementioned reasons, the Applicant respectfully points out that the Examiner does not make a prima facie case of obviousness under 35 U.S.C. § 103. The applicant respectfully asserts that claims 2 – 10 are allowable under 35 U.S.C. § 103 and respectfully requests that the rejection be withdrawn.

B. The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable for obviousness over McKissic in view of U.S. Patent No. 6,767,245 to King.

Again, the Examiner does not make a prima facie case of obviousness under 35 U.S.C. § 103 because the prior art reference does not teach or suggest all the claim limitations. As pointed out above, the McKissic reference fails to teach or describe any of the elements recited in claim 1 and claim 2. The Examiner makes no attempt to show where King remedies any of the deficiencies in McKissic. Indeed, McKissic and King disclose similar plug-in type modules that are completely different than the present claimed invention. Consider that, by virtue of its dependency from claim 2, claim 11 requires a first switch, a second switch, and a receptacle. Accordingly, the Examiner does not show where McKissic or King, whether taken alone or in combination, teach or suggest a device that includes all of these elements.

The Examiner also does not make a prima facie case of obviousness under 35 U.S.C. § 103 because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. McKissic shows a plug-in switch. King also shows a plug-in switch OR a plug-in receptacle – thus, King provides no suggestion whatsoever to modify McKissic to provide a device that includes a first switch, a second switch, AND a receptacle as recited in the claims.

In light of the aforementioned reasons, the applicant respectfully asserts that claims 11 – 12 are allowable and respectfully requests that the rejection under 35 U.S.C. § 103 be withdrawn.

C. The Examiner has rejected claims 13 – 18 and 27 under 35 U.S.C. § 103 as being unpatentable for obviousness over McKissic in view of U.S. Patent No. 3,707,697 to Izumi.

The Examiner again fails to make a prima facie case of obviousness under 35 U.S.C. § 103 because the prior art references do not teach or suggest all the claim limitations. As

pointed out above, the McKissic reference fails to teach or describe any of the elements recited in claim 1. The Examiner does not show where Izumi remedies any of the deficiencies in McKissic relative to claim 1. Once again, Izumi is similar to the McKissic reference in that it is a plug-in type device and is, as such, totally different than the instant claimed invention. The dependent claims 13 – 18 and 27 are allowable in their own right.

The Examiner also does not make a prima facie case of obviousness under 35 U.S.C. § 103 because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner argues that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to make McKissic’s modular device with a receptacle as taught by King to provide the modular device with means for plugging electrical cables for providing power to different electrical devices.”

The applicant respectfully points out that the phrase “it would have been obvious to one of ordinary skill in the art at the time the invention was made...” implies that the references are being combined to arrive at the claimed invention as a whole. On the other hand, the Examiner makes the combination for providing a “modular device with means for plugging electrical cables for providing power to different electrical devices,” a device totally different from what is being recited in the claims. Because the Examiner’s motivational statement asserts that the combined references do not arrive at the claimed invention as a whole, but rather to another invention, the Examiner’s motivational statement is a tacit admission that the claimed invention is not obvious in light of the combination of McKissic and Izumi.

Accordingly, the applicant respectfully asserts that claims 13 – 18 and 27 are allowable and respectfully requests that the rejection under 35 U.S.C. § 103 be withdrawn.

## 5. Conclusion

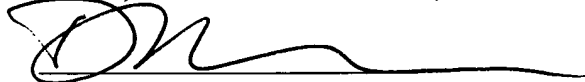
Based upon the remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 27 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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